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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,775	04/09/2004	Dejan Jovovic	071308.0537	1452

31625 7590 08/29/2006

BAKER BOTTS L.L.P.  
PATENT DEPARTMENT  
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AUSTIN, TX 78701-4039

EXAMINER
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COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/821,775

Applicant(s)

JOVOVIC ET AL.

Examiner

Eric B. Compton

Art Unit

3726

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.



Eric B. Compton  
Primary Examiner  
Art Unit: 3726

## DETAILED ACTION

### *Remarks*

1. Applicant's arguments filed in the After-Final Response dated August 15, 2006, have been considered but are not found persuasive.
2. Applicant first argues that BIOTRONIK is non-analogous art. See Response, page 3, ¶ 2. In the Final Rejection the Examiner argued the even if BIOTRONIK is non-analogous prior it is nonetheless directed to the same problem Applicant faced, and thus proper for establishing a prima facie case of obviousness. See Final Rejection, Page 6.
3. Applicant then argues that BIOTRONIK does not propose to use a filler within the hollow body, e.g., stent, since it does not fill the entire interior of the space of an object.<sup>1</sup> See Response, page 3, ¶ 3. In response to Applicant's argument that BIOTRONIK fails to show a filler that fills entire interior space of hollow body, this limitation is not recited in the rejected claim(s). Claim 3 only requires the limitation, "wherein during beam/jet cutting a filler is inserted in the hollow body". Nowhere does the claim require such a rigid definition that the filler must fill the entire interior of the space of an object. Although the claims are interpreted in light of the specification, limitations from the specification (or otherwise) are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, this limitation is only briefly discussed in Specification. See Section [0017] ("A first embodiment of the method according to the invention provides that, by using a suitable filler inside the hollow

cylinder during beam/jet cutting, a defined shaping of the beam/jet outlet edge is achieved and damage to the opposite side is prevented.”). Therefore, Applicant's own disclosure does not support the definition of “filler,” as couched by Applicant, that it must fill the entire interior space of hollow body either.

4. Applicant relies on a filler to provide cutouts having proper dimensions and to minimize damage to the opposite side during beam/jet cutting. *Id.* In beam cutting, a high-energy beam is used to remove material. This high-energy beam will cause heating of the hollow body. Applicant too is presumably seeking to reduce the heating effects of the beam on the opposite side of the hollow body to minimizing damage. BIOTRONIK discloses a method for cutting holes in thin-wall tubular stock by laser cutting to form a hollow body, e.g., a surgical stent, which incorporates a ceramic support to absorb heat and *minimize distortion*. See Derwent Abstract. As shown in Figures 1 and 2, the tubular stock (6) is placed on the core (5) for laser beam cutting. The fact that the core absorbs heat inherently prevents the heat from distorting the hollow body, including the area opposite the cutouts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Oki to provide a support core, in light of the teachings of BIOTRONIK, in order to “absorb heat and minimize distortion” due to laser cutting. Derwent Abstract, title.

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<sup>1</sup> Applicant points out that “A filler, per definition, fills the entire interiors space of an object.” *Id.* However, Applicant offers no evidence of a *per se* definition of the term “filler” as such.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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